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(For Patent Owner)

**MAILED**

**SEP 13 2002**

**REEXAM UNIT**

In re reissue application of  
Johansson, et al.

Application No. 09/659,377

Filed: September 7, 2000

For: U.S. Patent No. 5,229,068

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:  
: DECISION VACATING  
: FINAL OFFICE ACTION  
: IN REEXAMINATION  
: PROCEEDING  
:  
: AND  
: DECISION MERGING  
: REEXAMINATION  
: AND REISSUE  
: PROCEEDINGS  
:  
:

In re Johansson, et al.  
Reexamination Proceeding  
Control No. 90/005,098  
Filed: September 3, 1998  
For: U.S. Patent No. 5,229,068

The above-identified reissue application and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,229,068 issued to Johansson et al., on July 20, 1993.
2. A request for reexamination of the '068 patent was filed by patent owner on September 3, 1998, and the resulting reexamination proceeding was assigned Control No. 90/005,098.

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3. On November 18, 1998, reexamination was ordered in the '5098 proceeding.
4. The examiner issued an Office action in the '5098 reexamination proceeding on June 6, 2000, rejecting all of the outstanding patent claims raising, *inter alia*, the issues of new matter and broadening, as well as 35 U.S.C. 112 (1<sup>st</sup>) and 35 U.S.C. 112 (2<sup>nd</sup>) paragraph issues.
5. On September 6, 2000, patent owner filed an amendment in the '5098 reexamination proceeding.
6. Patent owner filed a reissue application based on the '068 patent, on September 7, 2000, which was assigned Application No. 09/659,377. Claims 1-14, 17-19, 21 and 45-71 were canceled, claims 15, 16, 20, 22, 27, 28, and 35 were amended, and claims 72-74 were added. In the reissue application, patent owner alerted the Office of the co-pending '5098 reexamination proceeding, and stated that the purpose of filing the reissue application was to have the two proceedings merged and examination continued under the reissue rules. In this regard, patent owner stated in the first paragraph of the reissue application: "Merger of the Reexamination and Reissue is requested, with examination to proceed in accordance with 35 U.S.C. 1.171 through 1.179 (sic)."
7. On April 9, 2001, the Office mailed a "Notice of Missing Parts of Reissue Application / Filing Date Granted" in the reissue application.
8. Patent owner filed a paper submitting the noted missing parts of the reissue application on September 10, 2001.
9. On October 2, 2001, the reissue application was forwarded to Technology Center 3600 for examination.
10. The examiner issued a final rejection in the '5098 reexamination proceeding on October 4, 2001, setting a 2-month shortened statutory period for response, in which claims 15-16, 20, 22-24, and 107-109 were rejected.
11. On October 15, 2001, a preliminary amendment was filed in the reissue application placing the same amendments in the reissue application as were submitted in the '5098 reexamination proceeding. The specification was amended,

claims 72-74 were canceled, claims 75-106 were added and canceled, and claims 107-109 were added. On page 13 of the amendment, patent owner stated: "Should the USPTO merge the two proceedings as previously requested, subsequent amendments will be made in the manner called for in Section 2285C. Action on the merged proceedings under the normal Reissue rules is requested."

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12. Patent owner filed a request for an extension of time to respond to the final rejection in the '5098 reexamination proceeding, on October 23, 2001. In the request for an extension of time, patent owner again alerted the Office of the co-pending reissue application, and inquired as to why the files had not yet been forwarded to the Commissioner's Office for a decision on the merger issue in accordance with MPEP 2285C. Patent owner requested the extension of time "in order to have the question of merger decided." Patent owner correctly noted that if the proceedings were merged, the merged proceeding would be conducted under the reissue rules and not the reexamination rules. Patent owner stated: "In order to fully understand applicant's options with respect to going forward with the prosecution of this case, a decision on the issue of merger is critical and applicant therefore requests this additional one month time period for response, with the hope and expectation that a decision on the merger will have been made so that applicant can then go forward as appropriate."
13. Notice of the filing of the reissue application was published in the *Official Gazette* on October 30, 2001.
14. On December 4, 2001, the Group Director of Technology Center 3600 mailed a decision in the '5098 reexamination proceeding granting the request for a one month extension of time to respond to the outstanding final rejection of October 4, 2001. In the decision the Group Director noted: "Patent Owner requests an extension of one month to January 4, 2002 in order to have the question of merger decided and for Patent Owner to have the opportunity to decide on how to proceed."
15. Patent owner filed a response to the final rejection in the '5098 reexamination proceeding on January 4, 2002. On pages 5-6 of the response patent owner once again alerted the Office of the co-pending reissue application, and requested that a decision on merger be made by the Office. Patent owner stated: "Applicants specifically request (and this may

be considered a petition if necessary, with any required fee authorized to be charged to the deposit account identified on the cover sheet of this amendment) that the pending reissue and reexamination proceedings be merged prior to any further Office Action in this reexamination proceeding."

16. An advisory action in response to the January 4, 2002, amendment after final rejection has not been mailed in the '5098 reexamination proceeding.
17. On April 4, 2002, the 6-month statutory period for filing a response to the October 4, 2001, final Office action expired. No Notice of Appeal has been received in the '5098 reexamination proceeding.

**VACATING OF FINAL OFFICE ACTION OF OCTOBER 4, 2001,**  
**IN REEXAMINATION PROCEEDING**

A review of the records of the reexamination and reissue files shows that the patent owner filed the reissue application on September 7, 2000, for the purpose, *inter alia*, of effecting a merger of the reissue and reexamination proceedings, in order to have the examination conducted under the reissue rules in lieu of the reexamination rules. In this regard, patent owner, in the first paragraph of the reissue application papers, alerted the Office of the existence of the co-pending reexamination proceeding and of the reason for the filing of the reissue application (merger of the proceedings). Further, on October 15, 2001, patent owner filed a preliminary amendment in the reissue application, placing the same amendments in the reissue application as were submitted in the reexamination proceeding. In the preliminary amendment, patent owner noted that under MPEP 2285C, amendments in a merged proceeding will be governed by the reissue rules, and again requested the merger of the proceedings and examination under the reissue rules.

The records further show that on October 4, 2001, a final rejection was mailed in the reexamination proceeding. On October 23, 2001, patent owner filed a request for an extension of time to respond to the final Office action. In the request for an extension of time, patent owner alerted the Office of the co-pending reissue application, and inquired as to why the files

were not forwarded to the Commissioner's Office for a decision on the merger issue, in accordance with MPEP 2285C. Patent owner requested the extension of time in order to have the question of merger decided. On December 4, 2001, the Group Director granted a one month extension of time, noting that patent owner requested an extension for one month to January 4, 2002, in order to have the question of merger decided and for Patent Owner to have the opportunity to decide on how to proceed.

On January 4, 2002, patent owner filed a response to the final rejection of October 4, 2001. On pages 5-6 of the response, patent owner again alerted the Office of the co-pending reissue application, and specifically requested that a decision on merger be made by the Office. Patent owner stated that, if necessary, this request for merger may be considered a petition that the pending reissue and reexamination proceedings be merged, prior to any further Office Action in this reexamination proceeding.

MPEP 714.13 provides (page 700-185) :

Any amendment timely filed after a final rejection should be immediately considered to determine whether it places the application in condition for allowance or in better form for appeal. An examiner is expected to turn in a response to an amendment after final rejection within 10 calendar days from the time the amendment is received by the examiner. A reply to an amendment after final rejection should be mailed within 30 days of the date the amendment is received by the Office.

MPEP 2272 (FINAL REJECTION - TIME FOR RESPONSE) provides:

The statutory period for response to a final rejection in a reexamination proceeding will normally be two (2) months. If a response to the final rejection is filed, the time period set in the final rejection continues to run. ... Any advisory Office action (form PTOL-467) issued in reply to patent owner's response after final rejection will inform the patent owner of the automatic 1 month extension of time. ... Note further that the patent owner is entitled to know the examiner's ruling on a timely response filed after final rejection before being required to file a notice of appeal. Notification of the examiner's ruling should reach the patent owner with sufficient time for the patent owner to consider the ruling and act on it. Accordingly, the period for response to the final rejection should be appropriately

extended in the examiner's advisory action. See *Theodore Groz & Sohne & Ernst Beckert Nadelfabrik KG v. Quigg*, 10 USPQ2d 1787 (D.D.C. 1988). The period for response may not, however, be extended to run past 6 months from the date of the final rejection.

MPEP 2285C (Reexamination Proceedings Underway, Reissue Application Filed) provides:

When a reissue application after a reexamination proceeding has begun following an order therefor, the reexamination, patent, and the reissue files should be forwarded to the Office of Patent Legal Administration (OPLA) for consideration as to whether or not to merge the proceedings or stay one proceeding.

- The record clearly shows that the Office failed to follow its established procedures in two respects. First, despite two attempts in the reissue application and two attempts in the reexamination proceeding by patent owner to have the issue of merger of the proceedings addressed, the Office failed to do so. Further, notwithstanding the filing of the reissue application, which should have resulted in consideration of merger of the proceedings, a final rejection was mailed in the reexamination proceeding.
- Second, patent owner filed an amendment to the final Office action in the reexamination proceeding with three months remaining in the six month statutory period for response to an Office action. An advisory action should have been mailed within 30 days of the receipt of the amendment after final. No such advisory action has been mailed to date. Further, if an advisory action had been mailed, the examiner would have been required to extend the time for response to provide appropriate time for response (i.e., to file a notice of appeal). If, when mailing the advisory action, insufficient time remained in the original six month response period for the patent owner to timely respond, the examiner (to be in accordance with the *Groz & Sohne* decision, *supra*) would have been compelled to vacate the final Office action and re-mail the final Office action setting a new period for response (i.e., a shortened statutory time period in a new six month period).

In view of all of the above, it is appropriate that the final

Office action of October 4, 2001, be *ab initio* vacated<sup>1</sup>, and that the reissue and reexamination proceedings be merged. Accordingly, the final Office action of October 4, 2001, in the '5098 reexamination proceeding is hereby, *ab initio*, vacated. The amendment after final Office action filed on January 4, 2002, will not be entered into the reexamination file.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d) :

(d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '5098 reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings,

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<sup>1</sup>the Office action must be *ab initio* vacated to preclude the termination of the reexamination proceeding for failure to timely respond within the six month statutory period for response to an Office action

consideration will be given to the status of each proceeding.  
See MPEP 2285.

A review of the prosecution history of the '5098 reexamination file shows that amendments to the claims were made in the reexamination file. A final rejection was mailed in the '5098 reexamination proceeding on October 4, 2001, setting a two month shortened statutory period for response, in which claims 15-16, 20, 22-44, and 107-109 were rejected. Patent owner was granted a one month extension of time to provide such response, and a proposed response to the final rejection was received on January 4, 2002. An advisory action has not been mailed, but since the final rejection of October 4, 2001, has been *ab initio* vacated, as indicated *supra*, the response will not be entered.

A review of the reissue (Application No. 09/659,377) prosecution history shows that the reissue application was published in the *Official Gazette* on October 30, 2001. The application is awaiting a first Office action on the merits by the examiner. In the reissue application, patent owner has canceled claims 1-14, 17-19, 21 and 45-71, amended claims 15-16, 20, 22, 27-28 and 35, and added claims 72-74. Patent owner then amended the specification, canceled claims 72-74, added claims 75-106 and then canceled claims 75-106, and added claims 107-109 for consideration. Patent owner has indicated that they filed this preliminary amendment in the reissue application in order to place the same amendments in the reissue application as were submitted in the reexamination proceeding. Thus, the claims appear to be identical in both proceedings, with the exception of one typographical difference in claim 37. In order to provide efficient and prompt handling of both proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be conducted in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND  
REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

Since the patent owner has repeatedly requested merger of the reexamination and reissue proceedings, and the final Office action in the reexamination proceeding has been *ab initio* vacated in order to enable such requested merger, the above-identified reissue and reexamination proceedings are merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

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II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination file for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d).

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding.

Each Office action issued by the examiner will take the form of a single action which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data for both of the cases, i.e., the reissue application and the reexamination proceeding. Each action will be physically entered into both files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with **two copies being filed** for entry in both files, with each of the two copies bearing a signature, and containing identifying data for both of the cases (i.e., the reissue Application No. and the reexamination proceeding Control No.).

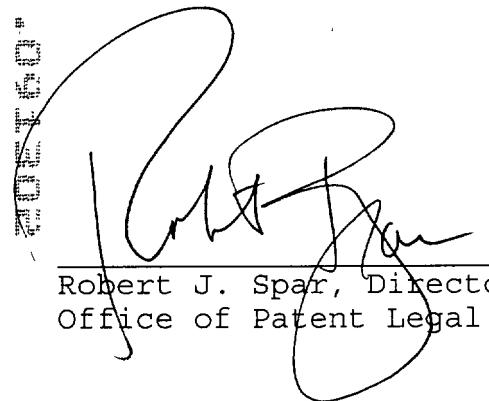
If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

CONCLUSION

1. The final Office action mailed October 4, 2001, in the '5098 reexamination proceeding is hereby *ab initio* vacated.
2. The above-identified reissue application and reexamination proceeding **ARE MERGED** into a single consolidated proceeding.
3. The reissue application file and the reexamination file are being forwarded to the Group Director of Technology Center 3600.
4. The examiner should immediately issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding. All further examination should be conducted in accordance with Parts II and III of this decision.
5. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703) 308-0255.

  
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Robert J. Spar, Director  
Office of Patent Legal Administration

September 12, 2002